

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 15-16 are rejected under 35 U.S.C. 102(b) over the patent to Happe.

Claims 1-5, 7-12 and 14-18 are rejected under 35 U.S.C. 103 over the patent to Stiltz or over the patent to Stiltz in view of the patent to Bitter and Vassos.

Claims 6 and 13 are also rejected over the patent to Stiltz in view of the patent to Tsai or over the patent to Stiltz in view of the patent to Tsai, Vassos and Zagar.

Also, the abstract of the disclosure and the amendment to and claim 16 was rejected under 35 U.S.C. 112.

In connection with the Examiner's formal objections and rejections, applicants have provided a new abstract of the disclosure,

amended claim 16 and also amended other claims. It is believed that the grounds for the formal objections and rejections are therefore eliminated.

After carefully considering the Examiner's grounds for the rejection of the claims, applicant has amended the dependent claims and also added new dependent claims 19, 20, 21.

The support for claim 19 can be found on page 9, line 18, to page 10 to page 4, where it is stated that the disc 40 is rotatable in a limited fashion between the neighboring claws 39a, b. Since the disc 40 is connected for joint rotation with the intermediate shaft 17 and the claws 39a, b are formed on the toothed gear 16, the toothed gear 16 is rotatable relative to the intermediate shaft 17. The rotary coupling of the toothed gear with the intermediate shaft by the arresting coupling is clearly described on page 9, lines 18-20. The support for claim 20 can be found in the specification on page 11, in the first paragraph. The support for claim 21 can be found in the specification on page 10, lines 5-10.

Since the specification was referring to the same structure as "an arresting device" and "an arresting coupling", the specification and the

claims have been amended to provide a single term for the same structure, in particular the "arresting coupling".

Turning now to the Examiner's rejection of the claims 15 and 16 over the patent to Happe, it is respectfully submitted that this reference discloses a spindle lock mechanism which has been known for a long time. An operator arrests the spindle 20 by a button 26.

It is respectfully submitted that in view of the changes made in the independent claims, the independent claims should be considered as patentably distinguishing over this reference. The arresting button arrests the motor shaft and is not arranged on the intermediate shaft.

The patent to Happe does not disclose an arresting coupling as now defined in the claims, but instead discloses an arresting device with an arresting button, which is not a coupling and not suitable for this purpose. Moreover, the element of the arresting device disclosed in the patent to Happe which must be formed as the arresting button is not arranged on any shaft.

Some original claims were rejected over the patent to Happe under 35 U.S.C. 102 as being anticipated. With respect to the anticipation rejection, it is believed to be advisable to cite the decision *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not disclose all elements of the present invention, which are now defined in the amended independent claims as required by the anticipation rejection.

It is therefore respectfully submitted that the anticipation rejection of the original claims over the patent to Happe should be considered as no longer tenable with respect to the amended independent claims.

The independent claims are further rejected over a combination of the patents to Stiltz and Bitter. From the grounds of the rejection it is believed that the Examiner meant the patent to Tsai instead of the patent to Bitter. The Examiner's arguments reside essentially in that the arresting

coupling disclosed in the patent to Tsai can be integrated in the percussion drill of the patent to Stiltz, and it would be obvious to arrange the arresting coupling of the patent to Tsai on the motor shaft 21 of the patent to Stiltz. In the Examiner's opinion the motor shaft 21 can be replaced by the input shaft and the output shaft of the patent to Tsai, and the motor shaft can be subdivided into two parts and the arresting coupling of the patent to Tsai can be integrated between the two parts of the motor shaft. Thereby the input shaft of the patent to Tsai can be interpreted as a motor shaft, so that the arresting coupling is arranged between the intermediate shaft and any element, for example the bearing of the motor shaft.

The currently amended independent claims define the new feature which can not be derived from the above mentioned interpretation, since in the amended independent claims the arresting coupling is arranged on the intermediate shaft. The arrangement of the arresting coupling on the intermediate shaft is neither disclosed in the patent to Tsai nor can be considered as obvious from it. Applicants can agree with the Examiner's conclusion that a person of ordinary skill in the art might arrange the arresting coupling of the patent to Tsai on the motor shaft of the percussion drill of the patent to Stiltz as proposed in the Office Action. However, this

would not lead to the applicant's invention as now defined in the independent claims.

The present invention as defined in the amended independent claims is not disclosed in the references and can not be derived from them as a matter of obviousness since the references do not contain any hint or suggestion for the modification proposed in the independent claims. In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified, in particular by redesigning their constructions and including into them the features were first proposed by the applicant and now introduced into the independent claims. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Definitely, the references do not contain any hint or suggestion for such modifications.

The Examiner's attention is further respectfully directed to the features of claim 2. Applicants respectfully disagree that the features of this claim can be considered as obvious from the combination of the patents to Stiltz and Tsai, since claim 2 defines the claws of the arresting coupling arranged at an end side of the toothed gear. With the arrangement of the arresting coupling on the motor shaft 22 disclosed in the patent to Stiltz, as described in the Office Action, the claws of the patent to Tsai would be arranged on the input shaft of the patent to Tsai and at the motor side. The toothed gear end 21 of the patent to Stiltz would be arranged on the output shaft of the patent to Tsai, which is formed as a toothed gear for engagement in the toothed gear 20. The input shaft leads however to the motor of the patent to Stiltz and thereby is not designed as a toothed gear. The output shaft can be designed as a toothed gear, whereby the claws however would not be arranged at an end side of the output shaft. The claws are spaced at a certain distance from the output shaft, since the output shaft and the claws must move relative to one another. Moreover, the claws extend in the radial direction over the ring 50 in the patent to Tsai and therefore extend in a radial direction outwardly beyond the output shaft.

If for the sake of argument, the input shaft, without any technical sense, was designed as a toothed gear, then the claws of the patent to Tsai nevertheless would not be arranged at the end side of the input shaft but instead at the end side on the disc 20 of the patent to Tsai.

The Examiner stated in the Office Action that the whole arresting coupling is arranged at the end side on the toothed gear. This is not however what is defined in claim 2. In claim 2 it is specifically defined that only the claws are arranged at the end side of the toothed gear, and this feature can not be derived from the combination of the patent to Stilts and Tsai.

Claim 7 was rejected over the combination of the patent to Stilts and Tsai for the reasons which were not explained by the Examiner. It is respectfully submitted that claim 7 specifically defines that the disc and the toothed gear are supported on the intermediate shaft. If the patents to Tsai and Stilts were combined with one another, the disc 50 would be arranged on the output shaft and thereby on the toothed gear end 21 of the patent to Stilts, and not on the intermediate shaft 19. A toothed gear with the claws arranged at the end side of claim 2 can not be derived from the combination of the patent to Tsai and Stilts. This combination provides even

less support for arrangement of the toothed gear on the intermediate shaft.

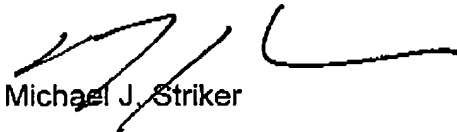
The same arguments are applicable with respect to claims 9 and 14.

In view of the above presented remarks and amendments, it is respectfully submitted that the present application should be considered as allowable and such action is earnestly solicited.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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